

## REMARKS

The last Office Action of June 21, 2006 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-13 are pending in the application. Claims 2-13 have been amended. Claim 1 has been canceled. No claims have been added. Amendments to the specification have been made. No fee is due.

It is noted that the specification is objected to because of some informalities.

It is further noted that claims 1-13 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1, 2, 4, 6, 8-10 and 12 are also rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-9 and 11-13 stand rejected under 35 U.S.C. §102(b) as being anticipated by the article authored by Lo (hereinafter "Lo").

It is noted with appreciation that claim 10 is indicated allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

## OBJECTION TO THE SPECIFICATION

In response to the objection to the specification, paragraphs [0013], [0026], [0030] and [0031] have been amended to eliminate minor informalities noted by the examiner. Paragraphs [0026] and [0027] have also been amended for the sake of clarity: adding the respective designations "5" and "8" to the PLC and geometric kinematic models, as supported in paragraph 0028, and changing "with"

to "and". No new matter has been added.

Withdrawal of the objection to the specification is thus respectfully requested.

#### **REJECTION UNDER 35 U.S.C. §112, FIRST PARAGRAPH**

The rejection of claims 1-13 as filed, under 35 U.S.C. §112, first paragraph, as failing to provide necessary written description is hereby respectfully traversed. The words "in a (suitable) manner (way) well-known in the art" were added to the translated text of the German patent application, and have been deleted as superfluous. The original disclosure is, in itself, sufficient to enable one skilled in this art to make and use this invention and does not include such recitations.

Withdrawal of the rejection of the claims 1-13 under 35 U.S.C. §112, first paragraph is thus respectfully requested.

#### **REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH**

The rejection of claims 1-2, 4, 6, 8-10 and 12, as amended, under 35 U.S.C. §112, second paragraph, as vague and indefinite is hereby respectfully traversed.

In original claim 1, the recitation "using said desired axis values" in line 12 has been extended to include an explicit recitation of the linguistically implied "said mathematical models" for the sake of clarity. However, applicant respectfully points out that said mechanism model means "being connected for receiving \_\_\_ from \_\_\_(x)\_\_\_ and supplying \_\_\_ to \_\_\_(y)\_\_\_" in line 15 does particularly point out and specifically claim the connections of said mechanism model means to (x) and (y), as required by 35 U.S.C. §112, second paragraph. Claim 10 has been rewritten to include the elements formerly recited in claim 1.

In claims 2 and 4 "computer" has been changed to "auxiliary computer" for the sake of consistency, as suggested by the examiner.

In claim 6, "a computer" has been changed to "the computer" for the sake of clarity.

In claim 8, the phrase "is adapted to be" has been deleted for the sake of clarity.

In claim 9, "machine" has been changed to "mechanism" and "downstream" has been deleted, for the sake of consistency.

In claim 10, applicant respectfully points out that "actual" and "desired" refer to types of values that describe axes, not to types of axes. However, for the sake of clarity, "one of the axes" has been changed to explicitly recite the adjective used to describe the axes: "one of the multiple axes". Also, because of the amendment of claim 10 to include the elements of claim 1, "has" is changed to "having" in claim 10.

In response to the rejection of claim 12 for the same reasons as were stated with reference to claim 1, claim 12 is amended as discussed above for claim 1.

Withdrawal of the rejection under 35 U.S.C. §112, second paragraph is thus respectfully requested.

#### **REJECTION UNDER 35 U.S.C. §102(b)**

Applicant has rewritten claim 10 in independent form, as suggested by the Examiner, who indicated that originally filed claim 10 would be allowable if rewritten in independent form. Accordingly, applicant asserts that claim 10 has not been narrowed to trigger prosecution history estoppel. See *Salazar v. Procter & Gamble Co.*, 75 USPQ2d, 1369 (stating that introducing claim 7 based on the allowable subject matter of dependent claim 3 of the "149 application was not a narrowing amendment for purposes of patentability and, therefore, does not by itself give rise to prosecution history estoppel).

Claim 1 has now been canceled, and claims 2-9 have been amended to make them dependent on claim 10. Independent claims 11-13 have been amended to incorporate the subject matter of claim 10.

Withdrawal of the rejection under 35 U.S.C. §102(b) and allowance of

claims 2-13 are thus respectfully requested.

## CITED REFERENCES

Applicant has also carefully scrutinized the further cited prior art and finds it without any relevance to the claims on file. It is thus felt that no specific discussion thereof is necessary.

## CONCLUSION

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted

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